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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,058	12/11/2003	Hikaru Kobayashi	075834.00460	7840
33448	7590	10/16/2008		
ROBERT J. DEPKE LEWIS T. STEADMAN ROCKEY, DEPKE & LYONS, LLC SUITE 5450 SEARS TOWER CHICAGO, IL 60606-6306			EXAMINER MARINI, MATTHEW G	
			ART UNIT 2854	PAPER NUMBER
			MAIL DATE 10/16/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,058

Applicant(s)

KOBAYASHI ET AL.

Examiner

MATTHEW G. MARINI

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 8, 10-13, 15, 16, 25 and 34 is/are pending in the application.
- 4a) Of the above claim(s) 26-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 8, 10-13, 15, 16, 25 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/315,542.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Newly submitted claims 26-33 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 26 does not require the structure of the adhesive labels being in the form of a roll as seen in independent claim 6 and therefor is restricted based on original presentation. The fact that the medium could be in the form of sheets would require a completely different and separate apparatus. Both claims 26 and 30 are directed towards a different embodiment requiring structure for cutting in the width wise direction of the printing medium not found in claims 6 and 11, and therefor is restricted based on original presentation.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 26-33 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7, 8, 10-13, 25 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Hayama (JP 11-157137). Note: The examiner has relied upon U.S. Patent # 6,532,078 as an English translation of Hayama (JP 11-157137).

As to claim 7, Hayama teaches in Fig. 2 a roll-shaped printing medium, T1, for use in a roll printer, comprising; a printing surface, the top surface of T1, on which one or more images are capable of being printed; a printing layer that is releasably adhered to a release layer, Col. 14 lines 5-13, the release layer for holding said printing layer, top surface of T1, wherein the releasably adhered printing layer, top surface of T1, and the release layer are rolled together in a spiral shape for form a roll-shaped printing medium, as seen in Fig. 2, wherein an image-forming portion, i.e. the substrate tape, Col. 14 lines 5-13, of said printing medium has said printing layer, i.e. the top surface of T1, that has been cut along a conveying direction of the image printing medium, seen in Fig. 16A-C, at a width-wise interval corresponding to the dimension of said image in a width direction perpendicular to said conveying direction, depicted by F(1) through F(4), and wherein the image-forming portion of said roll has said printing layer that is not cut at all in a width direction perpendicular to the conveying direction, Fig. 16A-C.

As to claims 8 and 12, Hayama teaches in Fig. 2 a roll-shaped printing medium, T1, being used in a roll printer wherein said image forming portion, top surface of T1, extends substantially the entire longitudinal length of said print medium, T1, as seen in Figs. 16A-C.

As to claims 10 and 13, Hayama teaches in Fig. 2 a roll-shaped printing medium, T1, being used in a roll printer wherein there are at least three cuts, F(1)-F(4), made in the longitudinal direction of said printing layer, top surface of T1, as seen in Figs. 16A-C, and wherein each cut is spaced apart at a pre-determined distance in a direction perpendicular to the conveying direction of the print medium, T1, according to the printed image.

As to claim 11, Hayama teaches in Fig. 2 a printing medium, T1, for use in a printer comprising: a printing surface, the top surface of T1, on which one or more images are printed, Figs. 16A-C; a printing layer that is releasably adhered to a release layer, Col. 14 lines 5-13, the release layer for holding said printing layer, top surface of T1, wherein an image-forming portion, i.e. the substrate tape, Col. 14 lines 5-13, of said printing medium has said printing layer, i.e. the top surface of T1, that has been cut along a conveying direction of the image printing medium, seen in Fig. 16A-C, at a width-wise interval corresponding to the dimension of said image in a width direction perpendicular to said conveying direction, depicted by F(1) through F(4), and wherein the image-forming portion of said roll has said printing layer that is not cut at all in a width direction perpendicular to the conveying direction, Fig. 16A-C; and wherein an image, Fig. 16A-C, is printed on at least a portion of the printing layer of the image-forming portion of the printing medium, T1, in between the cuts formed in the conveying direction, as seen in Fig. 16A-C.

As to claims 25 and 34, Hayama teaches in Fig. 2 the roll-shaped printing medium, T1, wherein no further holes or cuts are formed in the printing medium, T1, in order to facilitate the accurate detection of a position of the printing medium.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
This application currently names joint inventors.

In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayama (JP 11-157137 in view of Nakada et al. (JP-04-49164).

As to claims 15 and 16, Hayama teaches all that is claimed in the above rejection of claims 7 and 11, except the longitudinal cuts formed in the printing layer of the

printing medium extend at least partially into said release layer but not all the way through said release layer.

Nakada et al. teaches in the English translation of the abstract a release paper of a label like tape being partially cut. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the cutter of Hayama to include the release paper half cutting capabilities taught in Nakada et al. because it would eliminated the possibility of label jams of the individual tapes as they are discharged but keeping the labels partially attached as one tape as the tape is discharged from the apparatus.

Response to Arguments

Applicant's arguments with respect to claims 7, 8, 10-13, 15, and 16 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW G. MARINI whose telephone number is (571)272-2676. The examiner can normally be reached on Monday-Friday 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571)-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew Marini

10/8/08

/Leslie J. Evanisko/

Primary Examiner, Art Unit 2854